

## REMARKS

Reconsideration and allowance of this application are respectfully requested. By this communication, claims 1-5, 8, 9, and 14 are amended and claim 17 is added. Support for the subject matter added to claim 17 can be found, for example, in paragraphs [0047] and [0051] of Applicants' disclosure. Claims 1-17 remain pending.

### Claim Objections

Claims 9 and 14 stand objected to for alleged informalities. This objection is moot because based on the updated status of the subject claims. Withdrawal of this objection is respectfully requested.

### Rejections Under 35 U.S.C. §112

Claims 5 and 9 are rejected under 35 U.S.C. §112, second paragraph as indefinite. Applicants respectfully traverse this rejection. However, in an effort to expedite prosecution, claims 5 and 9 have been amended to address these concerns. Withdrawal of this rejection is respectfully requested.

### Rejections Under 35 U.S.C. §103

Claims 1-16 stand rejected under 35 U.S.C. §103(a) as unpatentable over *Utsunomiya* (U.S. Patent No. 6,999,186) in view of *Kisaki* (U.S. Patent Pub. No. 2003/0035142), and further in view of *Terajima* (U.S. Patent No. 5,309,251). Applicants respectfully traverse this rejection.

In numbered paragraph 13 of the Office Action, the Patent Office alleges that *Utsunomiya* teaches every element recited in independent claims 1 and 14 and

dependent claim 9 except for a controller. The Office relies on *Kizaki* and *Terajima* in an effort to remedy these deficiencies.

As shown in Applicants' exemplary figure 1, a multi-function peripheral (MFP) includes a document reader 2 that reads original documents, and a printer unit 3 that prints image data onto paper or other medium. The MFP also includes a work memory 5 that stores image data received from the document reader 2, and an expansion memory mounting unit 12 that enables an expansion memory 14 to be mounted. The expansion memory 14 includes a file memory 6 and a compression/decompression controller 7. The compression/decompression controller 7 includes compression/decompression units 71-74 that process data forwarded from the work memory 5. The file memory 6 stores the image data compressed by the compression/decompression units 71-74. An expansion memory detection unit 13 detects whether a file memory 6 is mounted to the expansion memory mounting unit.

When a file memory 6 is mounted, image data stored in the work memory is forwarded to the compression/decompression controller 7 and stored in the file memory 6. When more than one copy of image data is to be output, the compressed data stored in the file memory is decompressed, sent to the work memory 5 and output to the printer unit 3.

When a file memory 6 is not mounted and more than one copy of image data is to be output, the image data is stored in the work memory 5 and output to the printer unit 3 upon execution of a print session. Thus, when the file memory 6 is not mounted the image data does not undergo compression/decompression processing.

Applicants' claims 1, 8, and 14 broadly encompass the foregoing embodiment. Claim 1 recites, in part, a processing memory that processes input job image data for a job and a controller that, when said job image data is to be output multiple times and, (i) if the expansion memory is mounted, stores the processed input job image data in a first storage destination memory for a second output session and beyond, and (ii) if the expansion memory is not mounted, stores the input job image data that is not processed in a second storage destination memory for a second output session and beyond (emphasis added).

Claim 8 recites, in part, a processing memory that processes the input image data of print jobs received by said receiving unit, and a controller that, when the print job includes multiple copies of identical images to be printed, (i) selects one of a first and second storage destination memories for storing the input image data that is not processed or the processed image data, respectively, of the second output session and beyond based on the detection of said detection unit, and (ii) reads out said image data from the selected storage destination memory and executes printing for a second copy onward via said printer unit (emphasis added).

Claim 14 recites, among other features, a work memory that includes a storage area used for storing the input image data for received print jobs, as well as a processing area used for converting the input image data to raster images, and a controller that, where the print job is a job in which multiple copies of identical images are to be printed, (i) and when said detection unit detects that an expansion memory is mounted, prints out a first copy of the processed image data processed in said work memory and stores the processed image data stored in said work memory in said expansion memory and executes printing for a second copy onward via the

printer unit using the processed input image data stored in said expansion memory, and (ii) when said detection unit detects that an expansion memory is not mounted, executes printing for the second copy onward via the printer unit using the input image data that is not processed and is stored in said work memory (emphasis added).

*Utsonomiya, Kizaki, and Terajima* fail to establish a *prima facie* case of obviousness because when relied upon individually or in combination they fail to teach every element recited in Applicants' claims.

*Utsonomiya* discloses a printing system in which both a RAM 1037 and an external memory unit 1043 store rasterized image data (see Fig. 3). The PTO alleges that Applicants claimed processed image data reads on the rasterized image data of *Utsonomiya*. Even assuming *arguendo* that this interpretation is accurate, which Applicants' do not believe that it is, *Utsonomiya* cannot disclose first and second storage destination memories as recited in Applicants' claims. Applicants' claimed first storage destination memory stores processed image data and the second destination memory stores image data that is not processed.

*Terajima* discloses a facsimile apparatus that enables an external memory to be detachably loaded. When a sensor detects that the external memory is loaded, a received communication is stored in the external memory. Alternatively, when the sensor detects that the external memory is not loaded, the communication result is stored in a RAM of the main body. If an external memory is later loaded through the main body, the communication result stored in the RAM is then copied to the external memory. The communication result as disclosed in *Terajima* includes information, such as, the telephone number and name of the communication partner,

ID information, start time, communication time, number of sheets, the communication status, and any charge for the communication. See col. 3, line 22 through col. 4, line 4; and Figs 2-4.

As noted above, *Terajima* discloses that the external memory stores additional print information. This additional information, however, does not include image data. Thus, even if *Terajima* is combinable with *Utsunomiya*, which Applicants' do not acquiesce that it is, *Terajima* still does not remedy the deficiencies of *Utsunomiya* with respect to Applicants' claimed first storage destination memory that stores processed image data and the second destination memory that stores image data that is not processed.

*Kisaki* is relied upon for its alleged teaching of a controller that prints a first copy and second copy onward as recited in the claim. *Kisaki* discloses that an image memory includes primary and secondary memory devices (606, 607), with the secondary memory device storing the same type of image data as the primary memory device for multiple copying print applications. See Fig. 6. *Kisaki* fails to remedy the deficiencies of *Utsunomiya* and *Terajima* in that, like *Utsunomiya*, *Kisaki* discloses that the first and second memory devices store the same type of data (i.e. compressed/decompressed data). Therefore, even assuming *arguendo* that *Kisaki* is combinable with the teachings of *Utsunomiya* and *Terajima*, which Applicants do not acquiesce that it is, a *prima facie* case of obviousness is still not established because the combined teachings do not disclose or suggest Applicants' claimed first storage destination memory that stores processed image data and the second destination memory that stores image data that is not processed.

On pages 2-7 of the Office Action, the PTO replies to several of Applicants arguments made in the previous response. Applicants respectfully submit that the foregoing remarks address and render moot the PTO's reply.

In sum, *Utsonomiya*, *Terajima*, and *Kisaki* when applied individually or in the combination relied upon by the PTO fail to disclose or suggest every element recited in Applicants' claims. Because none of the applied references teach or suggest Applicants' claimed first storage destination memory that stores processed image data and the second destination memory that stores image data that is not processed, one of ordinary skill would not have reason to look to *Terajima* and/or *Kisaki* to remedy the deficiencies of *Utsonomiya*. More importantly, even if *Terajima* arguably discloses the use of an external memory to store a communication result, one of ordinary skill would not have reason to combine this feature with the teachings of *Utsonomiya* and/or *Kisaki* to achieve the claimed results. Both *Utsonomiya* and *Kisaki* disclose concepts in which first and second memory units store the same type of image data (i.e., processed image data). Thus, because *Terajima* fails to disclose the storing of image data in the external memory unit, Applicants' question how one of ordinary skill would reasonably conclude that image data other than what is already disclosed as being stored in both *Utsonomiya* and *Kisaki* could be stored by *Utsonomiya* in an external memory. For at least these reasons, a *prima facie* case of obviousness has not been established.

The Office has the initial burden of establishing a factual basis to support the legal conclusion of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). For rejections under 35 U.S.C. § 103(a) based upon a combination of prior art elements, in KSR Int'l v. Teleflex Inc., 127 S.Ct. 1727, 1741,

82 USPQ2d 1385, 1396 (2007), the Supreme Court stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (emphasis added). For at least the foregoing reasons, withdrawal of this rejection is respectfully requested.

Applicants newly added claim 17 depends from claim 1 and is allowable for at least the same reasons discussed above with respect to the base claim. Moreover, claim 17 is further distinguishable over the applied references by the additional elements recited therein.

**Conclusion**

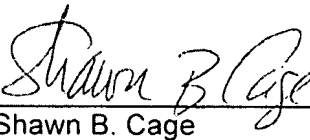
Based on at least the foregoing amendments and remarks, Applicants submit that claims 1-17 are allowable, and this application is in condition for allowance. Favorable consideration and allowance of this application are respectfully requested. In the event any issues remain, the Examiner is invited to contact Applicants' representative identified below.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: October 31, 2007

By:



Shawn B. Cage  
Registration No. 51,522

P.O. Box 1404  
Alexandria, VA 22313-1404  
703 836 6620